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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,921	04/13/2005	Rudolf Philipeit	2345-201	2036

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KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER	
MOORTHY, ARAVIND K	
ART UNIT	PAPER NUMBER
2131	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/511,921	PHILIPEIT, RUDOLF	
	Examiner	Art Unit	
	Aravind K. Moorthy	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 April 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *9-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *9-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 October 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the communications filed on 24 April 2005.

2. Claims 9-16 are pending in the application.

3. Claims 9-16 have been rejected.

4. Claims 1-8 have been cancelled in a preliminary amendment.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 9, 12, 13 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Skubic et al US 2002/0026584 A1 (hereinafter Skubic).

As to claim 9, Skubic discloses a method for electronically signing a message in a cellular phone, comprising:

> generating an electronic fingerprint (i.e. hash 15) from the message (i.e. document 10) to be signed, in a personal computer (i.e. web server 125) [0028]; transmitting the electronic fingerprint from the personal computer via a communications network to the cellular phone (i.e. mobile terminal 20) having a signing device (i.e. Skubic discloses that the hash 15 along with the document 10 and the request for the digital signature are forwarded at step 165 to the trusted

party 115 from the web server 125. The trusted party 115 sends at step 170 the hash 15 to the mobile terminal 20 over a communications channel 135.) [0028];

signing the received electronic fingerprint in the cellular phone (i.e. Skubic discloses the mobile terminal provides the digital signature at step 180) [0028]; and

transmitting the signed electronic fingerprint from the cellular phone to the personal computer (i.e. Skubic discloses that the mobile terminal provides the digital signature at step 180, and the mobile terminal 20 notifies the trusted party 115 of the signature at step 185. The trusted party validates the provided digital signature and updates and notifies the transaction as being signed at both the PC 120 and mobile terminal 20 at step 190) [0028].

As to claim 12, Skubic discloses that the electronic fingerprints are transmitted between the cellular phone and the personal computer using one of a Short Message Service (SMS), e-mail and Wireless Application Protocol (WAP) service (i.e. Skubic discloses The web server 280 provides the ability for the mobile terminal to connect to services in the PC 250. The WAP gateway 285 provides for the ability of a wireless device such as the Mobile electronic transaction device 260 to access the Internet using the WAP protocol through the customer PC 250. The WAP gateway 285 acts as an interface between a WAP network and a TCP/IP network such as the Internet. The WAP gateway 285 converts between the WAP and TCP/IP protocols) [0035].

As to claim 13, Skubic discloses a communication system for electronically signing, comprising:

at least one personal computer (i.e. web server 125) [0028] linkable to a communications network (i.e. WAP network and a TCP/IP network) [0035];

at least one cellular phone (i.e. mobile terminal 20) [0028] assigned to the communications network (i.e. WAP network and a TCP/IP network) [0035];

wherein the personal computer includes a device for generating an electronic fingerprint (i.e. hash 15) from a message (i.e. document 10) to be signed, and a transmitting/receiving device for transmitting the electronic fingerprint to any cellular phone (i.e. Skubic discloses that the hash 15 along with the document 10 and the request for the digital signature are forwarded at step 165 to the trusted party 115 from the web server 125. The trusted party 115 sends at step 170 the hash 15 to the mobile terminal 20 over a communications channel 135.) [0028]; wherein the cellular phone includes a receiving device (i.e. mobile terminal 20) for receiving an electronic fingerprint transmitted by the personal computer via the communications network [0028], a signing device for signing the received electronic fingerprint (i.e. Skubic discloses the mobile terminal provides the digital signature at step 180) [0028], and a transmitting device for transmitting the signed electronic fingerprint to the personal computer.

As to claim 15, Skubic discloses that the personal computer includes a second memory for storing software which enables the personal computer to communicate with the cellular phone [0028].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 10, 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skubic US 2002/0026584 A1 as applied to claims 9 and 13 above, and further in view of Kitaori et al U.S. Patent No. 5,915,024.

As to claims 10 and 14, Skubic discloses a mobile terminal 20 that digitally signs a document 10 [0021]. Skubic discloses that the signature is validated [0028].

Skubic does not explicitly teach how the mobile terminal signs the document. Skubic does not explicitly teach how the signature is validated at the computer.

Kitaori et al teaches a secret key [column 8, lines 19-22]. Kitaori et al teaches using the secret key on a digest to form an electronic signature [column 8, lines 19-22]. Kitaori et al teaches a public key that corresponds to the secret key that was used to forming the electronic signature [column 10, lines 17-25]. Kitaori et al teaches that a decrypter decrypts the electronic signature using the public key to obtain the digest [column 10, lines 13-16]. Kitaori teaches comparing digests to verify that the signature messages have not been altered [column 10, lines 36-50].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Skubic so that the mobile terminal would have stored a secret key. The web server would have stored a public key assigned to the secret key.

The hash would have been signed by the mobile terminal using the secret key. The signed hash would have been decrypted using the public key. A comparison would have taken place of the hash to verify that the signature message had not been altered.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Skubic by the teaching of Kitaori et al because it provides reliability and determines whether a document has been altered. A hash algorithm ensures data integrity through the detection of changes to the data caused by either communications errors ocurring in transit, or by tampering. In combination, hashing and the use of digital signatures prevent the forging of an altered message [column 4, lines 33-41].

As to claim 11, Skubic teaches that the electronic fingerprint is generated in accordance with a hash function from the message to be signed. Skubic teaches that the hash 15 along with the document 10 and the request for the digital signature are forwarded at step 165 to the trusted party 115 from the web server 125 [0028].

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Skubic US 2002/0026584 A1 as applied to claim 13 above, and further in view of Chae et al US 2003/0054862 A1.

As to claim 16, Skubic discloses that the web server 125 communicates with the mobile terminal 20 via a communications channel 135 [0026].

Skubic does not teach a third memory for storing the call numbers of at least one cellular phone and/or a target device. Skubic does not teach an automatic dial device for automatically dialing at least one of the cellular phone and a target device.

Chae et al teaches a mapped automatic call number in memory 113 [0033]. Chae et al teaches in step 519, the controller 111 dials the automatic call number registered in memory 113 to connect a call [0035].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Skubic so that there would have been a memory, in the web server, for storing an automatic call number. There would have been a automatic dial device in the web server for automatically dialing the mobile terminal 20.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Skubic by the teaching of Chae et al because it provides a method for automatically calling a user of a missing mobile telephone in a locked state [0008].

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K. Moorthy whose telephone number is 571-272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aravind K Moorthy/
Examiner, Art Unit 2131
/Ayaz R. Sheikh/
Supervisory Patent Examiner, Art Unit 2131